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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,462	08/30/2001	Christopher P. Carey	CE08796R	3246
22917	7590	06/30/2005	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			CHOW, MING	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/945,462	Applicant(s) CAREY ET AL.	
	Examiner Ming Chow	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

1. Claim 2 recites "that that" (line 3). The claim read as "that".

Also, claim 2 recites "call set setup" (line 7). The claimed should read as "call setup".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1, 3, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Broyles et al (US: 6665530).

Regarding claims, 1, 3, 5, Broyles et al teach on column 3 line 56 to column 4 line 34, a mobile station sends a first message (RAND and an authentication signature) to the communication network to invoke an authentication procedure at the network.

Broyles et al teach on column 6 line 26 to column 8 line 7, when the first authentication on the network fails, the authentication center sends a message including a unique authentication signature (claimed “first parameter”) generated by the authentication center and a unique challenge security value (claimed “second parameter”) to the MSC (MSC receives the claimed “a second message”). The unique challenge security value is transmitted from the MSC to the mobile station for generating a unique authentication signature by the mobile station (reads on claimed “the second parameter associated with a second authentication procedure”). The unique authentication signature (claimed “first parameter”) is generated only when the first authentication on the network fails, therefore, the unique authentication signature (claimed “first parameter”) indicates a status of the first authentication procedure.

Broyle et al teach on column 6 line 26 to column 8 line 7, the mobile station’s access is delayed (reads on claimed “determining not to initiate call setup”) until (claimed “prior to”) the unique challenge authentication is completed successfully.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al (US: 6665530) as applied to claim 1 above, and in view of Jung et al (US: 2001/0025345).

Regarding claims, 1, 3, 5, in addition to 35 USC § 102 rejections stated above, Broyles et al teach on column 3 line 56 to column 4 line 34, a mobile station sends a first message (RAND and an authentication signature) to the communication network to invoke an authentication procedure at the network.

Broyles et al teach on column 6 line 26 to column 8 line 7, when the first authentication on the network fails, the authentication center sends a message including a unique authentication signature (claimed "first parameter") generated by the authentication center and a unique challenge security value (claimed "second parameter") to the MSC (MSC receives the claimed "a second message"). The unique challenge security value is transmitted from the MSC to the mobile station for generating a unique authentication signature by the mobile station (reads on claimed "the second parameter associated with a second authentication procedure").

Broyle et al failed to teach "a first parameter indicating a status of the first authentication procedure". However, June et al teach on section [0058], a parameter indicating the reason of failure (claimed "status") of the authentication.

Broyle et al teach on column 6 line 26 to column 8 line 7, the mobile station's access is delayed (reads on claimed "determining not to initiate call setup") until (claimed "prior to") the unique challenge authentication is completed successfully.

It would have been obvious to one skilled at the time the invention was made to modify Broyle et al to have the "a first parameter indicating a status of the first authentication procedure" as taught by Jung et al such that the modified system of Broyle et al would be able to support the system users with a clear message about failure of the first authentication procedure.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al as applied to claim 1 above, in view of Servi (US: 5319711).

All rejections as stated in claim 1 above apply.

Broyle et al teach a first authentication. When the first authentication completes successfully (with a result of authentication failure), a second authentication is performed. The call is set up only when the second authentication authenticates the mobile station.

Broyle et al failed to teach "initiating a call setup before the authentication procedure has completed". However, Servi teaches on column 2 line 66-68, upon call initiation, an authentication is performed before the call is connected.

It would have been obvious to one skilled at the time the invention was made to modify Broyle et al to have the "initiating a call setup before the authentication procedure has completed" as taught by Servi such that the modified system of Broyle et al would be able to support the system users conveniences of initiating a call setup before the authentication is completed.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al as applied to claim 1 above, and in view of Jung et al, and further in view of Patel (US: 6591364).

The modified system of Broyle et al in view of Jung et al as stated in claim 1 above failed to teach the “second authentication procedure is an SSD update procedure”. However, Patel teaches on column 2 line 33-43, per IS-41, authentication procedure is an SSD update.

It would have been obvious to one skilled at the time the invention was made to modify Broyle et al in view of Jung et al to have the “second authentication procedure is an SSD update procedure” as taught by Patel such that the modified system of Broyle et al in view of Jung et al would be able to support the system users for further verification by updating the SSD.

Response to Arguments

6. Applicant's arguments filed on 2/25/05 have been fully considered but they are not persuasive.

- i) Applicant argues, on pages 5-6, regarding new amendments. New grounds of rejections necessitated by the new amendments have been stated above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow

A handwritten signature in black ink, consisting of a circle with a stylized 'M' inside.A handwritten signature in black ink, featuring a large, stylized 'F' and 'T'.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600